

### **REMARKS**

After entry of this response, claims 1-40 remain pending in the present application. Applicant respectfully requests reconsideration by the Examiner in light of the following remarks.

The United States Patent and Trademark Office (USPTO) has objected to the drawings because the features in Fig. 3 lack the clarity of the previously submitted Fig. 3. Similarly, the USPTO has objected to the specification because the "language used to define the first portion and the second portion of the shaft in claims lacks proper antecedent basis in the specification." Finally, the Examiner states that the declaration does not comply with 37 CFR 1.63 (a). Applicant has submitted a new declaration and corrected the drawings and specification thereby obviating the objections. Applicant respectfully requests withdrawal of the objection.

#### **I. Rejection under 35 USC §102 (The Wardle reference)**

Claims 1, 11, 16, 19, 20, and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Wardle (US 4,748,969). Applicant respectfully traverses.

The Wardle reference fails to teach or suggest a device having a first non-deflectable portion as stated, for example, in Claim 1. To the contrary, the express teachings of the Wardle reference disclose that first portion (14) is flexible and that this flexibility is required for the shaft to "follow the contours of the canal or tract." See col. 4, lines 27-28. Thus the express teachings of the reference fail to anticipate or suggest the device with a non-deflectable portion of claim 1.

The device disclosed by Wardle is characterized by the USPTO as having a first portion (14), a second portion (12), and a deflectable tip extending from the second portion that has a tapered portion. Based upon the express disclosure of the reference, the characterization of the cross-sectional side view of the distal region of the instrument of Wardle as being "a deflectable tip extending from the second portion," is unsupportable. Rather, Fig. 1 of the Wardle reference simply

discloses two distinct portions 14 and 12, and nothing more. See col. 4, lines 15-19. Moreover, the characterization of the objective head tip 48 as being tapered is also factually unsupportable based on the teachings of the reference. The Wardle reference discloses that the shaft 8 of the instrument has "a shaft circumference of about (10) French." See col. 6, lines 37-40. This teaching is consistent with a shaft having a uniform diameter—without a tapered portion contrary to the assertion by the USPTO.

Accordingly, independent Claim 1 and dependent Claims 11, 16, 19, 20, and 22 are not anticipated under 35 U.S.C. § 102(b) by the Wardle reference and Applicant respectfully requests withdrawal of the rejection.

## **II. Rejection under 35 USC §103**

### **a. Rejections based on Stewart and Hobot references**

Claims 2, 3, 7, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Stewart et al. (US 6,926,669). Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Hobot et al. (US 2003/0109823). Claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Ponzi and further in view of Stewart. Claims 28 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Ponzi, in view of Stewart, and further in view of Hobot. Claims 30-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Ponzi, in view of Stewart, in view of Hobot, and further in view of Truckai. Applicant respectfully traverses the rejections.

The Stewart and Hobot references are disqualified as prior art under 35 U.S.C. §103(c). The present application and the Stewart and Hobot applications were, at the time the invention of the present application was made, owned by Medtronic, Inc.

**b. Wardle and Truckai references**

Claims 6 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle. Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle in view of Truckai (US 5,397,304).

The Truckai reference fails to remedy the deficiencies of the Wardle reference discussed with respect to the rejection under 35 U.S.C. §102(b) in section I above. Furthermore, in the rejection, Wardle is the primary reference and is applied in the same manner as applied against claim 1. Claims 6, 8-10 and 12 properly depend from claim 1 and being a dependent claim is allowable therewith.

**c. Wardle and Ponzi references**

Claims 13-15, 17, 21, 23-26, and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Ponzi (US 5,897,529).

Contrary to the USPTO's assertion, the Wardle reference fails to teach or suggest a compressible member positioned between the distal end of the transition tubing and the anchoring band as stated, for example, in claim 23. The Wardle reference discloses that buckling of the shaft is prevented, which precludes the USPTO's assertion of the presence of a compressible member. See col. 6, lines 28-31. Thus the assertion that the disclosure of the Wardle reference supports the proposition of a teaching of a compressible member is factually unsupportable. As such, the Examiner's combination modification of the Wardle reference (which lacks a compressible member) with the Ponzi reference is without merit and the rejection should be withdrawn. Moreover, the Ponzi reference fails to cure the defects of the Wardle reference discussed in section I above.

Consequently, Applicant respectfully requests withdrawal of the rejection of claims 13-15, 17, 21, 23-26, and 40 under 35 U.S.C. §103(a) as being unpatentable over Wardle, in view of Ponzi.

### III. Conclusion

In view of the foregoing, Applicant respectfully asserts that the present claims are in condition for allowance. Withdrawal of the instant rejections and issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

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